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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,939

12/30/2003

Markus A. Wicki

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07/05/2007

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

07/05/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/748,939	Applicant(s) WICKI ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7,8,10,11,13-17 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2,4-5,7-8,10-11,13-17,20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/06/07 has been entered.

The Status of Claims

Claims 1-2,4-5,7-8, 10-11,13-17, 20-30 are pending.

Claims 1-2,4-5,7-8, 10-11,13-17, 20-30 are rejected.

DETAILED ACTION

1. Claims 1-2,4-5,7-8, 10-11,13-17, 20-30 are under consideration in this Office Action.

Priority

2. None.

Drawings

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3. None.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2,4-5,7-8, 10-11,13-17, 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babler et al (Tetrahedron Letters, 1979, no. 22, p. 1971-74).

Babler et al teaches a selective esterification method of treating diol with a solution of acetic acid in the presence of sulfuric acid at a room temperature to produce the monoacetate (see page 1971, lines 17-19) free from the corresponding diacetate derivatives, which is done by continuous extraction with a suitable nonpolar solvent (see page 1973, lines 1-3). Furthermore, various starting diols compared with glacial acetic acid are described below (see page 1972, table 1):

TABLE I						
Starting Diol ^a	Aqueous Reaction Mixture (ml of H ₂ O: ml of glacial acetic acid: ml of conc. H ₂ SO ₄)	Time ^b	Solvent Used for Extraction ^c	Product Distribution ^d		
				Diol	Monoacetate ^e	Diacetate
15 mmol of 1,10-decane-diol	155:75:0.25	36 hrs	5:1 (v/v) cyclohexane: CCl ₄	39 ^f	60	1
15 mmol of 1,10-decane-diol	120:90:0.25	36 hrs	1:1 (v/v) hexane: cyclohexane	22 ^f	75	3
15 mmol of ethylene glycol	160:80:0.50	1 wk	benzene	0	94	6
17 mmol of 1,4-cyclohexanediol ^g	180:45:4.0	4 days	benzene	14 ^h	85 ^f	1
7 mmol of 1,12-dodecane-diol	90:150:0.25	30 hrs	cyclohexane	29 ^f	66	5
13.7 mmol of 1,8-octane-diol	200:25:4.0	40 hrs	hexane	2	94	4

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acid. This mixture was subsequently extracted continuously with the specified nonpolar solvent. ^bThe time represents that required for essentially quantitative removal of the starting diol (most of which has been converted to the corresponding monoacetate) from the aqueous reaction mixture using the specific reaction conditions listed in the table. This time should be able to be reduced substantially by increasing the amount of sulfuric acid catalyst heating the aqueous reaction mixture to a moderate temperature (e.g., 50°C), varying the ratio of water-acetic acid (up to a certain point), and using a more efficient extractor. ^cThe solvents utilized in the above reactions do not necessarily represent the optimum one for each particular system. The latter can be ascertained only after extensive development of this process. Suitable nonpolar solvents include alkanes, cycloalkanes, aromatic hydrocarbons, halide derivatives of hydrocarbons, or mixtures thereof. ^dThe product mixture was isolated by cooling the solvent used for extraction to room temperature. Any unreacted diol present in the product mixture often precipitated out of the nonpolar solvent at this stage and could be recovered by simple filtration. After drying the filtrate over anhydrous K₂CO₃ and subsequent removal of the extraction solvent under reduced pressure, product ratios were determined by VPC analysis (6'x1/8" SE-30 column). Retention times: diester > monoacetate

(see page 1972, a lower part of paragraph).

To illustrate the utility of this selective esterification process, 1,8-octanediol monoacetate⁸ (2, n=6) was converted in two steps to the sex pheromone of the oriental fruit moth,⁹ a pest of peach orchards. Oxidation of the unprotected hydroxyl group using pyridinium chlorochromate¹⁰ afforded the previously reported¹¹ 8-acetoxyoctanal in 86% yield. Subsequent treatment of the latter aldehyde with the ylid derived from *n*-butyltriphenylphosphonium bromide¹² under "salt-free" conditions¹³ gave Z-8-dodecenyl acetate,¹⁴ > 98% pure by VPC analysis,¹⁵ in 45% yield.

(see

page 1973, a middle paragraph).

The instant invention, however, differs from the prior art in that the carboxylic acid has a solubility in water of at least 20 % by weight at 20 °C ; the aprotic solvent has a polarity index between 1.5 and 3.5; the reaction step is conducted as a batch process.

With respect to the solubility of the acetic acid in water, it is well-known that the acetic acid is very soluble in water. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to find the solubility of the acetic acid in water by routine experimentation in order to discover the optimum range of the acetic acid in water for the reaction process.

Concerning the polarity index of the aprotic solvent, the reference is silent about it. However, the limitation of, pH, concentration, a polarity index does not impart patentability to a process when such values are those which would be determined by one of ordinary skill in the art in achieving optimum operation of the process. The polarity index of the solvent is well understood by those of ordinary skill in the art to be a result-effective variable, especially when attempting to control selectivity of a chemical process.

With respect to the claimed reaction step being conducted as a batch process, the prior art process is continuous as in the case of the extraction step. However, according to the a case law, it is well-established that batch and continuous processes are not patentably distinct. See, e.g., In re Dilnot, 319 F. 2d 188, 138 USPQ 248 (C.C.P. A. 1963). Therefore, it would have been obvious to the skilled artisan in the art to be motivated to conduct the prior art process as a batch process as an alternative.

Babler et al expressly teaches the selective esterification method of treating diol with a solution of acetic acid in the presence of sulfuric acid at a room temperature to produce the pure monoacetate by continuous extraction with the suitable nonpolar solvent (see page 1973, lines 1-3). The good selection of the polarity index of the solvent can be useful in attempting to control selectivity of a chemical process. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to optimize the continuous extraction with the suitable nonpolar solvent by routine


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experimentation on the selection of the polarity index of the solvent in order to maximize the desired product for the reaction process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Taylor Victor Oh, MSD,LAC
Primary Examiner
Art Unit :1625

6/22/07